

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114 and in light of the remarks which follow, are respectfully requested.

At the outset, Applicant thanks Examiner Shosho of the U.S. Patent and Trademark Office for her time and consideration in participating in an interview with Applicant's representative on June 14, 2004. During the interview, the Examiner stated that the filing of a declaration which shows that the ink of U.S. Patent No. 5,302,654 (*Ishii et al*) is not suitable for use as an ink jet ink, together with an amendment to the present claims such that the claims recite an "ink jet ink", may be effective to overcome the rejections of record (Interview Summary mailed July 16, 2004). In this regard, Applicant confirms that the Interview Summary accurately reflects the substance of the interview.

By the above amendments, each of the currently pending claims has been amended for clarification purposes to recite an ink jet ink. Entry of such amendments is proper at least because a Request for Continued Examination is being filed herewith. See 37 C.F.R. §1.114.

Claims 1, 3-7, 9-11, 13-15, 17, 19 and 21 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,302,654 (*Ishii et al*) in view of U.S. Patent No. 6,204,307 (*Miyabayashi*), U.S. Patent No. 6,384,108 (*Breton et al*) and either Japanese Patent Document No. 03-231975 (*JP '975*) or U.S. Patent No. 5,508,421 (*Suzuki et al*). Claim 16 stands rejected under 35 U.S.C. §103(a) as being obvious over *Ishii et al* in view of *Miyabayashi*, *Breton et al*, and either *JP '975* or *Suzuki et al*, and further in view of U.S. Patent No. 6,406,526 (*Meyrick et al*).

Claims 1, 3-7, 9-11, 13-15, 17, 19 and 21 stand rejected under 35 U.S.C. §103(a) as being obvious over *Ishii et al* in view of *Miyabayashi*, *Breton et al*, and U.S. Patent No.

5,344,933 (*Mikoshiba et al*). Claim 16 stands rejected under 35 U.S.C. §103(a) as being obvious over *Ishii et al* in view of *Miyabayashi*, *Breton et al*, and *Mikoshiba et al*, and further in view of *Meyrick et al*. Withdrawal of the above rejections is respectfully requested for at least the following reasons.

Ishii et al does not disclose or suggest each feature recited in claims 1 and 19. For example, *Ishii et al* does not disclose or suggest a block copolymer having an ionic group that is present in an amount from 0.2 mmol/g or more to 5.0 mmol/g or less, as recited in claims 1 and 19. This deficiency of *Ishii et al* has been acknowledged by the Patent Office in the Official Action at pages 5 and 8.

Furthermore, Applicant submits that *Ishii et al* fails to disclose or suggest an ink jet ink as recited in claims 1 and 19. In this regard, attached for the Examiner's consideration is an executed Declaration Under 37 C.F.R. §1.132 (Declaration) in which *Ishii et al* is discussed.

The Declaration compares various properties relating to ink jet ink performance of an ink jet ink according to the claimed invention and an ink of *Ishii et al*. As discussed at page 2 of the Declaration, the inventive ink jet ink was prepared in the same manner as "Ink 01" set forth at page 77 of the instant specification, and the ink of *Ishii et al* was prepared in the same manner as Example 5 set forth at column 6, lines 54-60 of *Ishii et al*.

Each of the above inks was tested to compare various properties relating to ink jet ink performance including ink stability, discharge stability, granularity, gloss, resistance against rubbing, and blurring. As shown in Table 1 of the Declaration, it was found that each of the tested properties of the ink of *Ishii et al* was inferior in comparison with the tested properties of the inventive ink jet ink. Moreover, with regard to the discharge stability, gloss and resistance against rubbing properties, the ink of *Ishii et al* was found to be not suitable for

practical use as an ink jet ink. Such deficiencies of the ink of *Ishii et al* are discussed in greater detail at pages 2 and 3 of the Declaration. As such, it is apparent that *Ishii et al* neither discloses nor suggests an ink jet ink as recited in claims 1 and 19.

Moreover, Applicant submits that the tests set forth in the Declaration show that the claimed invention can provide surprising and unexpected results in the form of improved properties relating to ink jet ink performance, i.e., ink stability, discharge stability, granularity, gloss, resistance against rubbing, and blurring, in comparison with the ink of *Ishii et al*.

Breton et al, JP '975, *Meyrick et al* and *Mikoshiba et al* fail to cure the above-described deficiencies of *Ishii et al*. In this regard, as set forth in the Interview Summary, the Examiner has stated that submission of a declaration which shows that *Ishii et al* is not suitable for use as an ink jet ink, would establish that there is no motivation to combine *Ishii et al* with *Breton et al*, JP '975, *Meyrick et al* and *Mikoshiba et al*. As discussed above, the attached Declaration shows that the ink of *Ishii et al* is not suitable for use as an ink jet ink. Accordingly, it is apparent that one of ordinary skill in the art would not have been motivated to modify *Ishii et al* in view of the above secondary applied documents in the manner previously suggested by the Patent Office.

Miyabayashi and *Suzuki et al* also fail to cure the above-described deficiencies of *Ishii et al*. In this regard, the Patent Office has relied on *Miyabayashi* for disclosing that ethylene glycol monoalkyl ether is a high boiling point solvent. The Patent Office has relied on *Suzuki et al* for disclosing the use of a particular oil-soluble dye (Official Action mailed November 24, 2003). However, like *Ishii et al*, neither *Miyabayashi* nor *Suzuki et al* discloses or suggests a block copolymer having an ionic group that is present in an amount from 0.2 mmol/g or more to 5.0 mmol/g or less, as recited in claims 1 and 19.

The present claims are not obvious over the applied art for at least the reasons discussed above. Accordingly, withdrawal of the §103(a) rejections is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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